

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PATRICK A. LAFFERTY

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Appeal No. 97-3144  
Application No. 08/372,390<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge, COHEN,  
and NASE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final  
rejection of claims 2 through 4, 6, 8, 9, 13, 15 and 18  
through 24. No other claims are pending in the application.

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<sup>1</sup>Application for patent filed January 13, 1995.

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Appellant's invention relates to an aircraft of the type having a plurality of longitudinally extending fuselages. As disclosed, the aircraft has a central fuselage 12 and a pair of additional fuselages 18 and 20, one on each side of the central fuselage. Claim 21, the only independent claim on appeal, calls for a plurality of sidewardly joined fuselages, connecting passages between the fuselages, retractable wings, forwardly mounted canards and a rearwardly mounted tail plane.

The appendix to appellant's brief contains a copy of the appealed claims except for claim 13. A copy of claim 13 is found on page 3 of the examiner's answer.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Oliver	Des. 127,158	May 13, 1941
Harrington	2,623,721	Dec. 30, 1952
Gibson	2,806,665	Sep. 17, 1957
Beteille	4,598,888	Jul. 8, 1986
Pedrick (GB)	1,439,086	Jun. 9, 1976

Claims 2, 3, 6, 8, 9, 13, 15, 18 and 20 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pedrick in view of Beteille and Gibson, claim 19 stands rejected under 35 U.S.C. § 103 as being unpatentable over

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Pedrick in view of Beteille, Gibson and Oliver, and claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pedrick in view of Beteille, Gibson and Harrington.

With regard to claims 2, 3, 6, 8, 9, 13, 15, 18 and 20 through 24, the examiner has made the following findings and conclusions:

Pedrick shows a plurality of fuselages (1-5) of substantially the same length and of a Boeing 747 (which the freight version has retractable noses to load and unload cargo through the nose and the passenger versions have seats and storage compartments) sidewardly joined, a pair of retractable wings 4",5" secured to the outward fuselages, rearwardly mounted tail planes, connecting skin on the nose of the different fuselages (the cross-hatched showing in figure 1), and the central section has at tail and the engines are indirectly attached thereto. Beteille teaches providing a jumbo fuselage with a canard control surface since it reduces the strain on the other lifting surface. Gibson shows retractable wings with engines mounted on the wings and fuel tanks that are collapsible. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the fuselages of Pedrick with inner-communicating passages since this would be an obvious expedient for passenger safety for escape purposes from the inner fuselages and it is also known that 747 fuselages have nose doors and would be obvious to so provide Pedrick. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the aircraft of Pedrick with canard airfoils as taught by Beteille since it provides more control and reduces strain on the other lifting surfaces. It would have been obvious to one having ordinary

skill in the art at the time the invention was made to substitute the retractable wings of Gibson for that of Pedrick since it is providing collapsible fuel tanks and outboard engines that provides a more efficient lifting surface. [Answer, pages 4-5]

With regard to claim 19, the examiner concludes in substance that the teachings of Oliver would have made it obvious to make the lengths of Pedrick's side fuselages shorter than the length of Pedrick's central fuselage for the reason stated on page 5 of the answer. With regard to claim 4, the examiner concludes that the teachings of Harrington "would have been obvious . . . to provide the aircraft of Pedrick with fuel tanks in recesses . . ." (answer, page 5).

Appellant does not take issue with the examiner's conclusion of obviousness regarding the provision of interconnecting passages between the fuselages, perhaps for the reason that Pedrick discloses the removal of inner fuselage walls to thereby provide interconnecting passages between the fuselages. See page 3, lines 3-9, of the Pedrick specification. Given this disclosure, the limitation pertaining to the passages is met by Pedrick, making it unnecessary to conclude that it would have been obvious to provide Pedrick's aircraft with such passages.

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In support of patentability, appellant first argues that Pedrick's disclosure is non-enabling. He also contests the examiner's positions of obviousness regarding the Beteille and Gibson references. In addition, on page 3 of the main brief, he seems to ignore the examiner's finding on page 4 of the answer that Pedrick's aircraft has a tail plane. He nevertheless concedes that Beteille discloses the combination of a tail plane (see page 3 of the main brief) and canards (see pages 3 and 6 of the main brief).

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments. As a result, we will sustain the § 103 rejection of claims 2, 3, 6, 8, 9, 13, 15 and 18 through 24, but not the § 103 rejection of claim 4.

Considering first appellant's argument that Pedrick lacks an enabling disclosure, appellant's main criticism with Pedrick's disclosure concerns Pedrick's objectives or goals of flying "across the ocean at altitudes ranging from 100 to 200 ft. and at speeds ranging between 300 and 400 knots" (main brief, page 3).

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Admittedly, a reference must be sufficiently enabling to practice appellant's claimed invention in order to serve as valid prior art under 35 U.S.C. § 102(b). See In re Paulsen, 30 F.3d 1475, 1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985), among others. It also is well established patent law that appellant bears the burden of introducing evidence that the applied reference (in this instance, Pedrick) lacks an enabling disclosure. See In re Fracalossi, 681 F.2d 792, 793, 215 USPQ 569, 570 (CCPA 1982). No such evidence has been presented in this case.

Instead, only arguments have been made in support of appellant's position as set forth in the briefs. Arguments of counsel, however, cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Furthermore, expressions of opinion by appellant's counsel, such as those set forth in appellant's briefs, are not considered to be dispositive of the enablement issue. See In re Reynaud, 331 F.2d 625, 627, 141 USPQ 515, 518 (CCPA 1964). For these reasons alone, appellant's non-enablement argument must fail.

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It also is well established that while a disclosure may be inoperative or non-enabling as to some of its features, its effectiveness as a reference is not removed as to other features which are clearly operative. In re Shepherd, 172 F.2d 560, 564, 80 USPQ 495, 497 (CCPA 1949). In the present case, even if it is assumed arguendo that the Pedrick reference does not contain an enabling disclosure for flying the multi-fuselage aircraft over oceans at the low altitudes ranging from 100 to 200 ft. and at speeds ranging between 300 and 400 knots, such a disclosure is not required to practice appellant's claimed invention.

For the foregoing reasons, we find no reversible error in the examiner's reliance on Pedrick to support his holding of obviousness.

Turning now to the obviousness issue, appellant has stated on page 2 of his main brief that claims 2, 3, 6, 8, 9, 13, 15, 18 and 20 through 24 have been argued as a group. We will therefore select claim 21 as being representative of this group, with the result that the remaining claims in the group shall stand or fall with the representative claim. See 37 CFR § 1.192(c)(7) as amended effective April 21, 1995. See also

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In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

With regard to claim 21, appellant does not contest the examiner's finding that Pedrick meets the recitation in clause "a" of a plurality of sidewardly joined longitudinally extending fuselages. Furthermore, the recitation of connecting passages in clause "a" is also met by Pedrick for the reasons stated supra.

In any event, appellant has not contested the examiner's conclusion that it would have been obvious to provide Pedrick's fuselages with connecting passages.

Pedrick also expressly discloses that the wings of the aircraft are retractable to meet the limitation in clause "b" of claim 21 (see page 2, lines 118-120, of the Pedrick specification). In this regard, the limitation in clause "b" is broad enough to read on Pedrick's retractable fan type wings. Claim 21 thus differs from Pedrick by reciting the canards in clause "c" and possibly the tail plane in clause "d".



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Beteille, however, expressly teaches the combination of canards 9 and a tail plane 6 for the advantageous purpose of relieving the airfoils of strains as discussed in column 1, lines 56-62, of the Beteille specification. This teaching would have been ample motivation for one of ordinary skill in the art to provide Pedrick's multi-fuselage aircraft with canards and a tail plane. We also agree that it would have been obvious to provide Pedrick's aircraft with canards for the reasons stated by the examiner on page 4 of the answer. Furthermore, since canards and tail planes are well known in the aircraft art, it follows that their advantages are also well known to further support the obviousness of equipping Pedrick's aircraft with such components. In this regard, the skilled artisan is presumed to know something about the art apart from what the references disclose. See In re Jacoby, 308 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962).

With regard to the argument made on page 6 of the main brief, there is no evidence that Pedrick's aircraft would not benefit from reduced strain and/or increased control. In any case, arguments of counsel cannot take the place of evidence. See In re Pearson, 494 F.2d at 1405, 181 USPQ at 646.

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As far as claim 21 is concerned, reliance upon Gibson does not appear to be necessary inasmuch as this claim is not limited to engines, let alone wing-mounted engines, or fuel tanks of any type. In any case, Gibson implicitly recognizes the advantage of retractable wings in the event that Pedrick's wings are not found to be "retractable" despite Pedrick's express teaching that the wings are retractable.

In view of the foregoing, we are satisfied that the combined teachings of the applied references would have suggested the subject matter of claim 21 to one of ordinary skill in the art to warrant a conclusion of obviousness under the test set forth in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Accordingly, we will sustain the § 103 rejection of claim 21 and also the § 103 rejection of claims 2, 3, 6, 8, 9, 13, 15, 18, 20 and 22 through 24 which, as noted supra, stand or fall with claim 21.

We will also sustain the § 103 rejection of claim 19. In the Pedrick reference, the lengths of the side fuselages 2 and 3 are clearly shown to be shorter than the length of the central fuselage 1. In any case, even if Pedrick's clear

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showing is not considered to meet the limitation in claim 19, it is of no moment that appellant may make the lengths of the side fuselages shorter than the length of the central fuselage for a reason other than that stated by the examiner (see the argument on page 7 of the main brief). In this regard, the law does not require that the references be combined for the reasons contemplated by appellant. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

We cannot, however, sustain the § 103 rejection of claim 4. Harrington's teaching of mounting fuel tanks in the sides of the fuselage of a single fuselage aircraft does not suggest the provision of a fuel tank between the central fuselage and each side fuselage of Pedrick's multi-fuselage aircraft.

Under the provisions of 37 CFR § 1.196(b), the following new ground of rejection is entered against claims 3, 4 and 6:

Claims 3, 4 and 6 are rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite and hence failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention. Antecedent basis is lacking for the recitation of "said side fuselages" (claims 3, 4 and 6) and

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also for the recitation of "said central fuselage" (claims 4 and 6).

The decision of the examiner to reject the appealed claims under § 103 is affirmed with respect to claims 2, 3, 6, 8, 9, 13, 15 and 18 through 24, but is reversed with respect to claim 4. In addition, a new ground of rejection has been entered against claims 3, 4 and 6.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter

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reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED-IN-PART  
37 CFR § 1.196(b)

	Harrison E. McCandlish, Senior	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Irwin Charles Cohen	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
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	Jeffrey V. Nase	)	
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